

Remarks

Applicants respectfully request reconsideration of the above-identified application. Claims 1, 4-6, 11, 14, 16-17, 19, 21-22, 27-29, 39-66 remain in this application. Claims 1, 4-6, 11, 14, 16-17, 19, 21-22, 27-29, 39-44 were withdrawn from consideration as directed to non-elected subject matter. Claims 2-3, 7-10, 12-13, 15, 18, 20, 23-26, and 30-38 were previously canceled. Applicants previously elected claims 45-66 for substantive examination.

I. Allowable Subject Matter.

Applicants note with appreciation the Examiner's statement that claims 46-47, 50-55, and 65-66 are directed to allowable subject matter.

II. Rejection Based on Haley and Baker

Claims 45 and 48 were rejected under 35 U.S.C. §103(a) as obvious in view of U.S. Patent 5,078,255 to Haley combined with U.S. Patent 6,453,644 to Baker. Applicants respectfully traverse this rejection.

The previous Office action states that Haley fails to teach or suggest "a machine capable of manufacturing a string of packaging cushions" as recited by independent claim 45. (Office action mailed Nov. 28, 2006 at section 3, page 2.) This is because the Haley cookie conveyor receives cookies from an upstream "cookie oven." (Col. 5, line 35.)

To supplement this shortcoming, the Office action cites Baker to show a machine capable of manufacturing a string of packaging cushions – namely, an "air pillow production machine 14" (column 4, lines 14-15).

The prior art fails to suggest the desirability of combining Baker with Haley. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The mere fact that Baker *could* be combined with Haley does not render the resultant combination obvious; the prior art must provide the teaching or suggestion supporting the combination. MPEP 2143.01.

The Office action states that the motivation for combining Baker with Haley is that the Haley conveyor "must have a manufacturing machine or supplying machine of sorts to

feed” the conveyor. (Office action mailed Nov. 28, 2006 at section 3, page 3.) However, Haley *does* have a supplying machine – namely, a *cookie* oven. (Col. 5, lines 34-36.)

The fact that Haley teaches a cookie oven cannot be ignored, because Haley must be considered as a whole. “A prior art reference must be considered in its entirety, i.e., as a *whole*, including the portions that would lead away from the claimed invention.” MPEP §2141.02 (emphasis in original). “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (C.C.P.A. 1965).

Since Haley teaches a cookie oven to supply cookies to the Haley conveyor, then actually in combining Baker with Haley, the Office action has substituted Baker’s air pillow production machine for Haley’s cookie oven.

There is quite a difference between Baker’s air pillow production machine and Haley’s cookie oven. Baker’s machine is directed to producing “air pillows from for example flat plastic film, folded plastic film, tubular plastic film or interconnected preformed open topped plastic bags.” (Column 4, lines 17-21.) In contrast, Haley’s machine uses an “oven conveyor belt” to move “dough balls” placed on the conveyor through an “open ended oven.” (Column 1, lines 25-32.) The former produces bags of air. The latter bakes cookies. The difference is as severe as the difference between a balloon and a cookie.

There is simply no reasoning provided based on the prior art to substitute an air pillow production machine for a cookie oven. The present application must not be used as a source of motivation for combining the Baker air pillow production machine with the Haley cookie conveyor to attempt to arrive at the present invention. Such hindsight is impermissible and must be avoided. MPEP 2142.

Further, even if Baker is combined with Haley, a *prima facie* case of obviousness also requires that the prior art provide a reasonable expectation that the proposed modification will succeed. (MPEP §2142.) The reasonable expectation of success must *not* be based on applicant’s disclosure. (*Id.*)

In the present case, the Office action fails to point out any rationale supporting that the Haley conveyor -- designed for conveying baked cookies -- would reasonably be expected to successfully transport the Baker string of air pillows. In fact, Baker teaches the use of a blower 18 to transport the air pillow through ductwork 22.

The rejected dependent claim 48 contains recitations in addition to those of the independent claim from which it depends, and is therefore further patentable over the combination of Haley and Baker.

### III. Rejection Based on Marschke and Baker

Claims 45, 49, 56-61, and 64 were rejected under 35 U.S.C. §103(a) as obvious in view of U.S. Patent 5,732,609 to Marschke combined with Baker. Applicants respectfully traverse this rejection.

The previous Office action states that Marschke fails to teach or suggest “a machine capable of manufacturing a string of packaging cushions” as recited by independent claim 45. (Office action mailed Nov. 28, 2006 at section 4, page 3.) This is because the Marschke conveyor receives paperboard from a “double backer” device that adhesively joins component paper webs together to form the corrugated paperboard. (Col. 2, lines 60-63.)

To supplement this shortcoming, the Office action cites Baker to show a machine capable of manufacturing a string of packaging cushions – namely, an “air pillow production machine 14” (column 4, lines 14-15).

The prior art fails to suggest the desirability of combining Baker with Marschke. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established because the prior art fails to provide the teaching or suggestion supporting the combination. (See MPEP 2143.01.)

The Office action states that the motivation for combining Baker with Marschke is that the Marschke conveyor “must have a manufacturing machine or supplying machine of sorts to feed” the conveyor. (Office action mailed Nov. 28, 2006 at section 4, page 3.) However, Marschke *does* have a supplying machine – namely, a “double backer.” (Col. 2, lines 60-63.)

The fact that Marschke teaches a double backer cannot be ignored, because

Marschke must be considered as a whole. (Supporting cites provided in the previous section.) Since Marschke teaches a double backer to supply corrugated paperboard to the Marschke conveyor, then actually in combining Baker with Marschke, the Office action has substituted Baker's air pillow production machine for Marschke's double backer.

Baker's air pillow production machine differs greatly from Marschke's double backer. Baker's machine is directed to producing "air pillows" as discussed in more detail in the previous section. In contrast, Marschke's double backer machine adhesively joins component paper webs to make corrugated paperboard, for example, of the type used to make cardboard boxes. (Column 1, lines 14-18; col. 2, lines 60-63.) The former produces bags of air. The latter makes cardboard.

There is simply no reasoning provided based on the prior art to substitute an air pillow production machine for a cardboard manufacture machine. The present application must not be used as a source of motivation for combining the Baker air pillow production machine with the Marschke cardboard conveyor to attempt to arrive at the present invention. Such hindsight is impermissible and must be avoided. MPEP 2142.

Further, even if Baker is combined with Marschke, a *prima facie* case of obviousness also requires that the prior art provide a reasonable expectation that the proposed modification will succeed. (MPEP §2142.) The reasonable expectation of success must *not* be based on applicant's disclosure. (*Id.*)

In the present case, the Office action fails to point out any rationale supporting that the Marschke conveyor -- designed for conveying cardboard -- would reasonably be expected to successfully transport the Baker string of air pillows. In fact, Baker teaches the use of a blower 18 to transport the air pillow through ductwork 22, as discussed above.

The rejected dependent claims contain recitations in addition to those of the independent claim from which they depend, and are therefore further patentable over Marschke combined with Baker. For example, Marchke and Baker fail to teach or suggest "at least one roll [that] comprises resilient foam" as recited in dependent claim 59.

#### IV. Obviousness Rejection Based on Marschke

Claims 62-63 were rejected under 35 U.S.C. §103(a) as obvious in view of Marschke.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established to shift the burden of rebuttal to the Applicant. One of the requirements of a *prima facie* case of obviousness is that the applied prior art reference must teach or suggest *all* of the claim limitations. MPEP §706.02(j).

Dependent claims 62-63 ultimately depend from independent claim 45. A dependent claim incorporates all of the recitations of the independent claim from which it depends. At the least, a *prima facie* case of obviousness has not been established with respect to dependent claims 62-63 because Marschke fails to suggest all of the limitations of independent claim 45, as discussed above.

A further requirement of a *prima facie* case of obviousness is that the prior art must provide a suggestion or motivation for the proposed modification. MPEP 2143.01. The mere fact that a reference could be modified does not render the modification obvious.

The previous Office action states that it merely would have been a design choice as to how the elements of a device are arranged. However, this statement fails to identify a reason or motivation in the prior art as to why the inlet end of the Marschke transport conveyor would be placed at “an elevation higher than” the outlet elevation of the Marschke “double backer” device that produces the corrugated paperboard web.

Marschke fails to present a reason to elevate the Marschke corrugated paperboard web after it was manufactured. And there are at least two reasons *not* to elevate the Marschke corrugated paperboard web after it exits the double backer device. First, elevating the paperboard web would unnecessarily increase the expenditure of energy during the process.

Second, Marschke teaches that although “the corrugated paperboard web 10 has some inherent flexibility, it cannot be bent too severely without causing a permanent lateral crease or break in the web.” (Col. 4, lines 59-65.) In fact, Marschke teaches a gradual change in direction over a sufficiently large radius curve to lower the corrugated paperboard. (*Id.*) Therefore, it would not make sense to elevate the corrugated paperboard web, because doing so

would not only risk creasing or breaking the paperboard on the rise, but also present the risk again when later lowering the paperboard back to the original elevation.

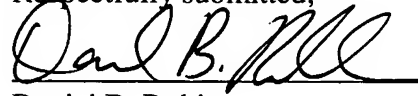
V. Conclusion

In view of these remarks, it is respectfully submitted that the present application is in condition for allowance. A notice to that effect is earnestly and respectfully requested.

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